

**Remarks/Arguments**

In an Office Action mailed August 27, 2003 (the "Office Action"), the Examiner:

- A. Allowed claims 74-75 per the earlier office action;
- B. Rejected claims 1-15, 18-29, 30-33, 37-56, 62-70, 76, 78-82, 101 and 109-112 under 35 U.S.C. 103(a) as being unpatentable over Alaia et al. (U.S. 6,408,283, "Alaia") in view of the article "Boston Ed RFP Seeks Between 132 MW and 306 MW; Bids Due Jan. 10, 1992" Independent Power Report, October 25, 1991 ("Boston Ed");
- C. Rejected claims 34-36 and 106-108 under 35 U.S.C. 103(a) as being unpatentable over Alaia and Boston Ed as applied to claim 1 and further in view of Walker et al. (U.S. 6,041,308, "Walker");
- D. Rejected claims 16 and 17 under 35 U.S.C. 103(a) as being unpatentable over Alaia and Boston Ed as applied to claim 1 and further in view of Chen (U.S. 5,991,737, "Chen"); and
- E. Rejected claims 57-61 and 106 under 35 U.S.C. 103(a) as being unpatentable over Alaia and Boston Ed as applied to claim 1 and further in view of Mori et al. (EP 0 828 223 A2, "Mori").

Applicants thank the Examiner for listening to remarks concerning the rejections cited above in a telephone interview on February 12, 2004. At the end of the telephone interview, the Examiner indicated that a final determination of whether the rejections would stand would be made after an amendment was filed. In response thereto, Applicants respectfully request reconsideration in view of the following remarks.

**REMARKS**

- A. **Allowance of claims 74-75 per the earlier office action**

Thank you.

- B. **Rejection of claims 1-15, 18-29, 30-33, 37-56, 62-70, 76, 78-82, 101 and 109-112 under 35 U.S.C. 103(a) as being unpatentable over Alaia et al. (U.S. 6,408,283, "Alaia") in view of the article "Boston Ed RFP Seeks Between 132 MW and 306 MW; Bids Due Jan. 10, 1992" Independent Power Report, October 25, 1991 ("Boston Ed")**

In the Office Action, the Examiner acknowledges that both Alaia and Boston Ed fail to teach step (d) in claim 1:

Alaia fails to teach step (d) automatically generating rating information about the seller offers . . . . Boston Ed, however, fails to teach that the generating rating information about seller's bids (offers) is automatically performed as per claimed invention.

*Office Action p. 4 (underline in original).*

Because both Alaia and Boston Ed fail to teach claim element 1(d), claim 1 (and all of its dependent claims) cannot be made obvious by Alaia in view of Boston Ed. Independent claims 2, 83, 95, and 112 each contain a claim element analogous to claim element 1(d) [i.e., 2(g), 83(d), 95(d), and 112(d)]. Thus, for the same reason, independent claims 2, 83, 95, and 112 (and all of their dependent claims) cannot be made obvious by Alaia in view of Boston Ed.

Even though the Examiner acknowledges that both Alaia and Boston Ed fail to teach step (d) in claim 1, the Examiner nevertheless finds claim 1 obvious by invoking the rule from *In re Venner* that "merely providing an automatic means to replace a manual activity which accomplishes the same result is not sufficient to distinguish over the prior art." *In re Venner*, 262 F.2d 91, 95 (CCPA 1958).

The Applicants respectfully point out that the Court of Appeals for the Federal Circuit has made it explicitly clear that the use of such a *per se* rule of obviousness is legally incorrect and not allowed:

The use of *per se* rules, while undoubtedly less laborious than a searching comparison of the claimed invention – including all its limitations – with

the teachings of the prior art, flouts section 103 and the fundamental case law applying it. *Per se* rules that eliminate the need for fact-specific analysis of claims and prior art may be administratively convenient for PTO examiners and the Board. Indeed, they have been sanctioned by the Board as well. But reliance on *per se* rules of obviousness is legally incorrect and must cease. Any such administrative convenience is simply inconsistent with section 103, which, according to *Graham* and its progeny, entitles an applicant to issuance of an otherwise proper patent unless the PTO establishes that the invention *as claimed* in the application is obvious over the prior art, based on the specific comparison of that prior art with claim limitations. We once again hold today that our precedents do not establish any *per se* rules of obviousness.

*In re Ochiai*, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995) (italics in original).

Moreover, in 2002, the Board of Patent Appeals and Interferences explicitly pointed out that the supposed rule stated in *In re Venner* is not a rule at all:

[The examiner] cited *In re Venner*, 262 F.2d 91, 120 USPQ 192 (CCPA 1958), for the supposed rule that it is obvious to automate a formerly manual process. . . We take this opportunity to point out that there are no *per se* rules of unpatentability. See *In re Ochiai*, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995).  
2002 WL 519771 (Bd.Pat.App & Interf.).

Thus, both the Court of Appeals for the Federal Circuit and the Board of Patent Appeals have made it clear that it is legally incorrect to use the *per se* rule from *In re Venner* to determine obviousness.

The Manual of Patent Examining Procedure discusses *In re Venner* in section 2144.04, "Legal Precedent as Source of Supporting Rationale," which is a subsection of section 2144, "Sources of Rationale Supporting a Rejection Under 35 U.S.C. 103." Section 2144 states:

LEGAL PRECEDENT CAN PROVIDE THE RATIONALE  
SUPPORTING OBVIOUSNESS ONLY IF THE FACTS IN THE CASE  
ARE SUFFICIENTLY SIMILAR TO THOSE IN THE APPLICATION  
(Capital letters in original, but underline added for emphasis)

Assuming for the sake of argument that it is legally permissible to apply the *per se* rule of *In re Venner* in general (even though, as shown above, such use is clearly wrong), it would still be wrong to apply the *per se* rule in this particular case because the facts in *In re Venner* are not sufficiently similar to the facts in the present application. For example, all of the claim limitations were disclosed in the prior art cited by the examiner in *In re Venner*. In sharp contrast, as noted by the Examiner, step (d) in claim 1 is not disclosed in the prior art cited in this case.

Indeed, the Patent Board raised this same lack of similarity in *Ex Parte Richard Brouillet, Jr.*:

The examiner argues . . . that "it has been held that broadly providing a mechanical or automatic means to replace manual activity which has accomplished the same result involves only route in [sic, routine] skill in the art. *In re Venner*, 120 USPQ 192."

.... In Venner, however, all limitations in the claims, including the automatic means, were disclosed in the applied references. See Venner, 262 F.2d at 96, 120 USPQ at 195.<sup>1</sup>

In the present case, unlike in Venner, the examiner has not provided a reference which discloses a high speed rotary power tool, let alone one which is used for cleaning glass. The examiner has merely relied on a *per se* rule that providing a mechanical or automatic means to replace manual activity which has accomplished the same result is unpatentable. As stated by the Federal Circuit in *In re Ochiai*, 71 F.3d 1565, 1572, 37 USPQ2d 1127, 1133 (Fed. Cir. 1995), "reliance on *per se* rules of obviousness is legally incorrect and must cease." Moreover, as correctly pointed out by the appellant . . . , the examiner has not established that manual rubbing accomplishes the same result as a rotary power tool.

2001 WL 1339914, p. 2 (Underlines added for emphasis.)

Lastly, because both Alaia and Boston Ed fail to teach step (d) in claim 1, it also follows that these prior art references cannot make claim 1 obvious because they fail to enable the performance of step (d) in claim 1:

---

<sup>1</sup> In particular, Venner at 96 states, "Venner et al. together with the Nichols and Wagner patents show the automatic means to initiate withdrawal of a core from a piston molding." (Underline added for emphasis.)

In order to render a claimed apparatus or method obvious, the prior art must enable one skilled in the art to make and use the apparatus or method. *Beckman Instruments, Inc. v. LKB Produkter AB* 892 F.2d 1547, 1551 (Fed. Cir. 1989).

Thus, Applicants respectfully request that all of the present 103(a) rejections be withdrawn because the Examiner has failed to establish a *prima facie* case for obviousness.

**C. Rejection of claims 34-36 and 106-108 under 35 U.S.C. 103(a) as being unpatentable over Alaia and Boston Ed as applied to claim 1 and further in view of Walker et al. (U.S. 6,041,308, "Walker")**

As explained in Remarks Section B above, all of the present 103(a) rejections should be withdrawn.

**D. Rejection of claims 16 and 17 under 35 U.S.C. 103(a) as being unpatentable over Alaia and Boston Ed as applied to claim 1 and further in view of Chen (U.S. 5,991,737, "Chen")**

As explained in Remarks Section B above, all of the present 103(a) rejections should be withdrawn.

**E. Rejection of claims 57-61 and 106 under 35 U.S.C. 103(a) as being unpatentable over Alaia and Boston Ed as applied to claim 1 and further in view of Mori et al. (EP 0 828 223 A2, "Mori")**

As explained in Remarks Section B above, all of the present 103(a) rejections should be withdrawn.

## CONCLUSION

In light of the foregoing, the rejections in the Office Action dated August 27, 2003 are believed to be traversed, and Applicants request that the rejections be withdrawn and the claims be passed to allowance.

If the Examiner believes a discussion of the above would be useful, he is invited to call the Applicants' attorney, Dr. Robert Beyers, at (650) 470-4624.

Respectfully submitted,

Date: February 25, 2004

Robert Beyers  
Robert Beyers, Ph.D.  
Reg. No. 46,552

SKADDEN, ARPS, SLATE, MEAGHER & FLOM LLP  
525 University Avenue  
Palo Alto, California 94301